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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/077,723	02/14/2002	C.J. Anthony Fernando	02-02 US	7904
23693	7590	07/29/2004	EXAMINER PAK, SUNG H	
Varian Inc. Legal Department 3120 Hansen Way D-102 Palo Alto, CA 94304			ART UNIT 2874	PAPER NUMBER

DATE MAILED: 07/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/077,723

Applicant(s)

FERNANDO ET AL.

Examiner

Sung H. Pak

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 12-17, 22 and 25-48 is/are pending in the application.
- 4a) Of the above claim(s) 25-48 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12, 13, 24 is/are rejected.
- 7) ☒ Claim(s) 12, 14-17 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 0504.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Applicant's amendment filed 5/07/2004 has been entered. Claims 12-17, 22, 25-48 are now pending. All pending claims have been carefully reconsidered by the examiner. In view of the amended claims, the previous ground of rejection is hereby withdrawn. However, upon further consideration, a new ground of rejection is furnished in this office action in response to the newly amended limitations.

### ***Information Disclosure Statement***

Information disclosure statement filed 5/07/2004 has been considered by the examiner. Please refer to the initialed copy of PTO-1449.

### ***Election/Restrictions***

Newly submitted claims 25-48 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 12-17, 22, drawn to subcombination apparatus for routing optical signal, classified in class 385, subclass 16.
- II. Claims 25-48, drawn to a combination apparatus and method for routing optical signal, classified in class 385, subclass 15.

The inventions are distinct, each from the other because of the following reasons:

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Inventions Group II and Group I are related as combination and subcombination.

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the particulars of the subcombination signal routing apparatus as claimed in claim 12 is not required for patentability of combination apparatus as evidenced by the independent claims 25, 34, and 39. The subcombination has separate utility such as fiber testing apparatus capable of testing plurality of fibers.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 25-48 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Claim Objections***

Claim 12 is objected to because of the following informalities: claim 12, lines 1-2 recites “over more or more”. The recitation should be changed to “over one or more”. The change is necessary to correct a minor typographical error. Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 12-13, 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kassel et al (US 3,697,185).

Kassel discloses an apparatus for selectively routing optical signals over one or more optical channels to and from sample test sites, comprising: an optical selection device comprising an internal optical fiber including an internal optical fiber output end ('302' Fig. 7), the optical channel selection device rotatable for aligning the internal fiber output end with a selected one of a plurality of available optical channels whereby an optical signal can be transmitted to a test site corresponding to the selected optical channel (Fig. 7, column 20 lines 32-68); plurality of fiber-optic return lines corresponding to the optical channels, each return line including a return line input end for receiving an optical signal from a test site and a return line output end fixedly

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supported (Fig. 7); wherein the plurality of optical channels and source line input ends are fixedly disposed in a circular arrangement (Fig. 7) and the internal optical fiber output end is alignable thru incremental rotation of the optical channel selection device (Fig. 7, column 20 lines 32-68)

Although Kassel does not explicitly disclose the use of a base and a mounting member, the use of base and mounting member is well known and common in the art. The use of base and mounting member is well known to be advantageous because they allow for precise positioning of rotary fiber optic components, such that coupling misalignment is minimized. Thus, the use of a base and a mounting member for fixedly disposing fiber optic component advantageously improves optical coupling efficiency.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the Kassel device to have a base and mounting member for fixedly disposing fiber-optic components.

#### ***Allowable Subject Matter***

Claims 14-17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

These claims are allowable in view of the terminal disclaimer filed 5/7/2004.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sung H. Pak whose telephone number is (571) 272-2353. The examiner can normally be reached on Monday- Friday, 9AM-5PM.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sung H. Pak  
Examiner  
Art Unit 2874

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**AKIM ENAYET ULLAH**  
**PRIMARY EXAMINER**